



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,321	03/16/2004	Linda J. Pinney	013499-9005-00	1994
23409	7590	02/22/2006	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP			TRAN, KHOI H	
100 E WISCONSIN AVENUE			ART UNIT	
MILWAUKEE, WI 53202			PAPER NUMBER	
			3651	
DATE MAILED: 02/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,321

Applicant(s)

PINNEY ET AL.

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13,15-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13,15-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/05, 05/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-11, 13, 15-23, and 25, in the reply filed on 12/23/2005 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement filed 04/14/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Accordingly, only 9 presented documents have been considered as indicated in the initialed form 1149/PTO.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 7-9, 11, 13, 15-17, 19-21, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenblum 6,892,941.

Rosenblum '941 discloses method for dispensing a prescription drug to a customer per claimed invention. The method comprises receiving a prescription for a customer from an authorized medical professional. The method comprises filling out the prescription and creating a finished prescription container from inherently choosing appropriate prescription from an inventory. The method comprises placing the prepackaged prescription container in a dispenser/storage randomly. The method comprises inherently recognizing the container location via a computer for subsequent dispensing per customer's request. The method comprises verifying authorized user at the dispenser/storage via an identification reader or via password recognition. The identification reader comprises magnetic stripe card reader, or a barcode reader. Rosenblum '941 method of authorizing dispensing comprises verifying user name and password, or verifying prescription number and password. Rosenblum '941 prescription dispenser comprises two-way video conferencing capability. Rosenblum '941 method comprises verifying of the dispensing of the finished prescription.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblum 6,892,941 in view of Robertson et al. 6,877,655.

Rosenblum discloses all elements per claimed methods including the usage of smartcard to authorize the dispensing transaction. However, it is silent as to the specifics of the user identification reader comprises a barcode reader.

Robertson et al. '655 shows a commonly well-known smart card having a barcode thereon for identification purposes. Robertson et al. '655 teach that it is commonly well known to use barcode for user's identification.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have provided Rosenblum '941 identification reader with a barcode reader because it facilitates another commonly well-known means for verifying authorized user, as taught by Robertson et al. '655.

8. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblum 6,892,941 in view of Denenberg et al. 6,874,684.

Rosenblum discloses all elements per claimed methods. However, it is silent as to the specifics of recording a customer's signature to purchase the finished prescription.

Denenberg et al. '684 disclose a medical dispensing system. Denenberg et al. '684 teach that electronic signature for authorizing purchases is commonly well known.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have provided to Rosenblum '941 with an electronic signature pad because it facilitates another means for authorizing a vending/purchasing procedure, as taught by Denenberg et al. '684.

9. Claims 1-4, 7, 8, 13, 15, 16, 19, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al. 6,814,255.

Liff et al. '255 discloses method for dispensing a prescription drug to a customer per claimed invention. The method comprises prepackaging prescription container per customer's prescription, which is obviously authorized by medical professional. The method of filing the prescription inherently comprises the selecting of drugs from an inventory of medications. Liff et al. '255 method comprises randomly placing the prepackaged prescription container in a dispenser 650. The method comprises recognizing the container location via a computer for subsequent dispensing per customer's request. The method comprises verifying authorized user at the dispenser/storage via an identification reader or via password recognition. Liff et al. '255 method of authorizing dispensing comprises verifying user name and password. Liff et al. '255 method comprises verifying of the dispensing of the finished prescription.

10. Claims 5, 6, 11, 17, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al. 6,814,255 in view of Robertson et al. 6,877,655.

In regards to claims 5, 6, 17, and 22, Liff et al. '255 discloses all elements per claimed invention including the usage of electronic card for authorizing the dispensing procedures. However, it is silent as to the specifics of the identification reader comprises a magnetic strip card reader or a barcode reader.

Robertson et al. '665 show of the commonly well-known electronic card that includes magnetic strip and barcode.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have provided to Liff et al. '255 reader with the capabilities of detecting magnetic strip and barcode because it facilitates the reading of commonly well-known electronic cards, as shown by Robertson et al. '655.

11. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al. 6,814,255 in view of Rosenblum 6,892,941.

Liff et al. '255 discloses all elements per claimed invention. However, it is silent as to the specifics of identifying a user based on a prescription number.

Rosenblum '941 discloses a method of dispensing authorized prescriptions using prescription number as means for identifying a user.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have used prescription number as user identification means within Liff et al. '255 method because it facilitates another means for identify user, as taught by Rosenblum '941.

In regards to claims 11 and 23, Liff et al. '255 is silent as to the specifics of photographing the customer during interaction with the dispenser.

Rosenblum '941 discloses two-way video communication at the dispenser for user interaction with the dispenser's administrative staff.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have provided video conferencing capability to Liff et al. '255 dispenser because it facilitates user's interaction with the dispenser's administrative staff, as taught by Rosenblum.

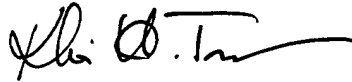
Conclusion

12. Additional references made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
02/16/2006